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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,962	01/21/2004	Hironobu Takizawa	17378	3889
23389 7590 10/27/2009 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER				
TOWA, RENE T				
ART UNIT		PAPER NUMBER		
3736				
MAIL DATE		DELIVERY MODE		
10/27/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/761,962

Applicant(s)

TAKIZAWA ET AL.

Examiner

RENE TOWA

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 11, 13-28, 30 and 32-53 is/are pending in the application.
- 4a) Of the above claim(s) 3, 11, 13-28, 30, 32-43, 45-49 and 51-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 17, 2009 has been entered.
2. This Office action is responsive to an amendment filed August 17, 2009. Claims 3, 11, 13-28, 30, 32-53 are pending. New claims 44-53 have been added. New claims 45-49 & 51-53 are withdrawn as pertaining to a non-elected invention. So far, claims 3, 11, 13-28, 30, 32-43, 45-49 & 51-53 are withdrawn. Claims 1-2, 4-10, 12, 29 & 31 have been cancelled.

Election/Restrictions

3. Newly submitted **claims 45-49 & 51-53** are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Pursuant to a restriction requirement mailed on January 19, 2006, the Applicant elected (i.e. species III, figures 5-7), without traverse, on February 26, 2006. For example, Applicant elected original claims 1-2, 4-5, 10, 12, 29 & 31 for prosecution without traverse (see pg. 2 of the Applicant's response dated February 26, 2006). Since original claim 1 presents the same subject matter as new claim 44, Applicant's exclusion of originally presented claim 3, which claims the same subject matter (i.e. "a bar-like

handle portion") as new claims 45-49 & 51-53, from the elected invention clearly shows that claims 45-49 & 51-53 fail to describe the invention of elected species III, which pertains to a net for retrieving, catching or holding the medical capsule. In fact, the instant specification only describes non-elected Species I (figs. 1, 3A & 4A-D) as comprising "a bar-like rod" or handle portion.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 45-49 & 51-53 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. **Claim 44** is rejected under 35 U.S.C. 102(b) as being anticipated by Brockman (US 3,540,433).

Brockman discloses a medical capsule retrieval device 20 comprising a holding unit 24 capable of holding a medical capsule discharged from a human body (*i.e. since the unit 24 is capable of holding tapeworms and pinworms*) (see figs. 1-5; column 3/lines 1-5, 7-13 & 15-22).

6. **Claim 44** is rejected under 35 U.S.C. 102(e) as being anticipated by Jurmain et al. (US 6,604,980).

Jurmain et al. disclose a medical capsule retrieval device 60 comprising a holding unit 60 capable of holding the medical capsule discharged from a human body (see fig. 4a-b).

7. **Claim 44** is rejected under 35 U.S.C. 102(e) as being anticipated by Samide (US 6,640,355).

Samide discloses a medical capsule retrieval device (10, 10') comprising a holding unit 20 capable of holding the medical capsule discharged from a human body (see figs. 1, 3 & 6; column 1/lines 49-55; column 2/lines 20-29 & 41-45; column 3/lines 8-13; column 4/lines 24-25 & 31-34).

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. **Claim 50** is rejected under 35 U.S.C. 103(a) as being unpatentable over Samide ('355) in view of Slover et al. (US 4,445,525).

Samide discloses a system, as described above, that teaches all the limitations of the claim except Samide does not disclose a bag to enclose together the medical capsule together with a unit of the capsule retrieval device. However, Slover et al. disclose a system comprising a bag to enclose together a sample together with a unit of the sample retrieval device (see column 4/lines 21-25). It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to provide a system similar to that of Samide with a collection bag similar to that of Slover et al. in

order to storage and transport of the collected specimen (see Slover et al., column 4/lines 21-25).

10. **Claim 50** is rejected under 35 U.S.C. 103(a) as being unpatentable over Samide ('355) in view of Paulin (US 4,309,782).

Samide discloses a system, as described above, that teaches all the limitations of the claim except for a bag to enclose the specimen together with a unit of the specimen retrieval device.

However, **Paulin** discloses a device comprising a bag 12 to enclose a specimen together with a holding unit 46 of the specimen retrieval device 16 for temporary storage or transport, after the specimen has been collected (see abstract; see figs. 1-3; col. 2, lines 20-32 & 62-67).

Since Paulin teaches a bag for a storing a medical retrieval device for temporary storage or transport to a physician's office or a laboratory, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to provide the system of Samide with a bag as taught by Paulin in order to store and/or transport the collected specimen to a physician's office and/or laboratory.

11. **Claim 50** is rejected under 35 U.S.C. 103(a) as being unpatentable over Brockman ('433) in view of Slover et al. (US 4,445,525).

Brockman discloses a system, as described above, that teaches all the limitations of the claim except Brockman does not disclose a bag to enclose together the medical capsule together with a unit of the capsule retrieval device. However, Slover et al. disclose a system comprising a bag to enclose together a sample together with a unit of

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the sample retrieval device (see column 4/lines 21-25). It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to provide a system similar to that of Brockman with a collection bag similar to that of Slover et al. in order to storage and transport of the collected specimen (see Slover et al., column 4/lines 21-25).

12. **Claim 50** is rejected under 35 U.S.C. 103(a) as being unpatentable over Brockman ('433) in view of Paulin (US 4,309,782).

Brockman discloses a system, as described above, that teaches all the limitations of the claim except for a bag to enclose the specimen together with a unit of the specimen retrieval device.

However, **Paulin** discloses a device comprising a bag 12 to enclose a specimen together with a holding unit 46 of the specimen retrieval device 16 for temporary storage or transport, after the specimen has been collected (see abstract; see figs. 1-3; col. 2, lines 20-32 & 62-67).

Since Paulin teaches a bag for a storing a medical retrieval device for temporary storage or transport to a physician's office or a laboratory, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to provide the system of Brockman with a bag as taught by Paulin in order to store and/or transport the collected specimen to a physician's office and/or laboratory.

Response to Arguments

13. Applicant's arguments filed August 17, 2009 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to RENE TOWA whose telephone number is (571)272-8758. The examiner can normally be reached on M-F, 8:00-16:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/R. T./
Examiner, Art Unit 3736

/Max Hindenburg/
Supervisory Patent Examiner, Art Unit 3736